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10/064,449	07/16/2002	Pedro P. Giralt	10682.3801	5790

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/064,449

Applicant(s)

GIRALT, PEDRO P.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Election*

Applicant's election without traverse of Group I and claims 1-5 in Paper No. 3 is acknowledged.

Claims 6 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 3.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations "a plurality of spacer plugs **having the same cross-sectional configuration as the cross-section of said bar channel**" and "said first bar and said second bar **in a parallel configuration with the plurality of pickets**" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Note that the drawings show that the cross-sectional configuration of the spacer plugs (22) is smaller and fits within the cross-section of the bar channel and therefore cannot be exactly the same as the bar channel. Also note that the drawings show the pickets to be perpendicular to the first and second bar, not parallel.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

Claims 1, 4 and 5 are objected to because of the following informalities:

- The phrase “said bar channel” (line 3 of claim 1) lacks proper antecedent basis in the claim. The phrase “recessed channel” (line 2 of claim 1) should be replaced with “recessed bar channel” to overcome this objection.
- The phrase “said rectangle” (line 8 of claim 1) lacks proper antecedent basis within the claim. The phrase “said rectangle (line 8 of claim 1) should be replaced with “said rectangular cross section”; and the phrase “substantially a predetermined cross section” (lines 7-8 of claim 1) should be replaced with “a substantially rectangular cross section” to overcome this objection.
- The phrase “said lower bar channel portions” (line 9 of claim 1) lacks proper antecedent basis within the claim and should be replaced with the phrase “lower bar channel portions”.
- The phrase “having the same cross-sectional configuration as the cross-section of said bar channel” (lines 10-11 of claim 1) does not accurately describe the drawings and should be replaced with “having a cross-sectional configuration complementary to, and fitting inside, the cross-section of said bar channel.
- The phrase “the desired distance” (lines 13-14 of claim 1) lacks proper antecedent basis within the claim and should be replaced with “a desired distance”.
- The phrase “said first bar and said second bar in a parallel configuration with said plurality of pickets” (lines 16-17 of claim 1) does not reflect what is shown in the

drawings and should be replaced with “said first bar and said second bar in a parallel configuration with one another; the plurality of pickets”.

- The phrase “said passage tabs” (line 12 of claim 1) lacks proper antecedent basis in the claim and should be replaced with “said tabs” for consistent claim terminology.
- The phrase “a plurality of spacer plugs” (line 18 of claim 1) is an unclear double inclusion of elements and should be replaced with “said plurality of spacer plugs”.
- The phrase “bottoms” (line 2 of claim 4) appears to be a typographical error and should be replaced with “bottom”.
- The phrase “the inclined angle” (line 3 of claim 5) lacks proper antecedent basis within the claims and should be replaced with “an inclined angle”.
- The phrase “safety plugs” (line 4 of claim 5) lacks proper antecedent basis in the claims and should be replaced with “spacer plugs” for consistent claim terminology.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made but maintains the applicants claim language in the prior art rejections below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters  
U.S. Patent 4014520.

Claim 1. Walters discloses (figs.1-3) an improved pedestrian and bicyclist safety railing comprising: a rigid top aluminum bar (14) having a longitudinal, recessed channel (portion of 14 receiving 40) protruding outwardly relative to the center of the bar, the bar channel having a predetermined cross-sectional configuration that includes a pair of tabs (24, 24a) forming upper and lower channel portions (above and below 24a) in the bar channel; a second bottom bar (18) substantially identical to the first bar ; a plurality of elongated, rigid pickets (20) having substantially a predetermined cross section, with the width of one dimension of the rectangle (cross sectional shape of 20) being sized for a snug fit into the lower bar channel portions (portions of 18 receiving 20); a plurality of spacer plugs (portions of 40 between 58) having the same cross-sectional configuration as the cross-section of the bar channel including a pair of recessed portions (portions of 42 receiving 24a) for receiving the passage tabs for holding and interlocking the spacer plug within the bar passage, the spacer plugs being sized in length to provide the desired distance apart between the pickets when in spaced engagement between adjacent pickets; and means (10, 10a) for joining the first bar and the second bar in a parallel configuration with the plurality of pickets connected between the first bar and the second bar in a common plane, and spaced apart by a plurality of spacer plugs.

Claim 4. Walters discloses (col.2, ll.5-10) the guard railing being constructed of aluminum. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, *i.e.* the functional limitation "to eliminate the welding

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joints between the pickets and the top and bottoms support bars in the guard railing", is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

Claim 5. Walters discloses the safety railing being **suitable for mounting** (but not necessarily mounted) on an inclined surface, the spacer plugs having end faces angled (at 90 degrees) substantially equal to the inclined angle (90 degrees) of the safety railing relative to the longitudinal axis of the safety plugs for snug engagement with each picket to separate adjacent pickets.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters U.S. Patent 4014520 in view of Grimm U.S. Patent 4421302.

Claim 2. Walters discloses the spacer plugs each being positioned between a pair of adjacent pickets and mounted within the top bar, the end face of each spacer plug being substantially perpendicular to the longitudinal axis of each spacer plug for engaging in contact

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with the side wall of a picket for holding the picket in position. Walters does not disclose the spacer plugs being positioned in the bottom bar. Grimm teaches (figs.4 and 7) spacer plugs (54) being positioned in both a top bar (24) and bottom bar (34) which appears to better support pickets (44). It has generally been recognized that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to duplicate the spacer plugs of Walters such that the railing of Walters has spacer plugs positioned in both the top bar and bottom bar, as taught by Grim, for the purpose of increasing picket support.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters U.S.

Patent 4014520 in view of Ballerstein U.S. Patent 5062732.

Claim 3. Walters discloses a first rigid post (10) and a second rigid post (10a) connected to the top bar and the bottom bar; and means (90b) for anchoring the first post and the second post to a concrete anchor (92) connected to the first post and the second post. Walters does not disclose a welding. Ballerstein teaches (col.1, ll40-45 and col.4, ll.9-14) that it is well known in the art to connect rails to posts by welding and then grinding the weld line for the purpose of presenting a stronger and smoother finished joint. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to connect the rails and posts of Walters by welding for the purpose of increasing strength and appearance of the rail to post joints.




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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



VLM  
October 20, 2003



***Lynne H. Browne***  
***Supervisory Patent Examiner***  
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